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Intellectual Property Administration  
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12-01-05

AF 12162  
PATENT APPLICATION *zpw*

ATTORNEY DOCKET NO. 10007376-1



IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Martha L. Lyons

Confirmation No.: 6080

Application No.: 09/774,727

Examiner: J. M. Corrielus

Filing Date: 01-31-2001

Group Art Unit: 2162

Title: CENTRALIZED CLEARINGHOUSE FOR COMMUNITY IDENTITY INFORMATION

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on 10-06-2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

(X) I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV629198717US, in an envelope addressed to: Board of Patent Appeals and Interferences, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450  
Date of Deposit: November 30, 2005

Respectfully submitted,

Martha L. Lyons

By *Thomas J. Meaney*

Thomas J. Meaney

Attorney/Agent for Applicant(s)

Reg. No. 41,990

Date: 11-30-2005

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Typed Name: Susan Bloomfield

Signature: *Susan Bloomfield*



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	§	
	§	
Martha L. Lyons	§	Confirmation No: 6080
	§	
Serial No. 09/774,727	§	Group Art Unit: 2162
	§	
Filed: January 31, 2001	§	Examiner: J. M. Corrielus
	§	
For: CENTRALIZED CLEARINGHOUSE FOR	§	
COMMUNITY IDENTITY INFORMATION	§	

**REPLY BRIEF**

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Fort Collins, Colorado 80527-2400

Docket No.: 10007376-1  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Martha L. Lyons

Confirmation No.: 6080

Application No.: 09/774,727

Group Art Unit: 2162

Filed: January 31, 2001

Examiner: J. M. Corrielus

For: CENTRALIZED CLEARINGHOUSE FOR  
COMMUNITY IDENTITY INFORMATION

**APPELLANT'S REPLY BRIEF (37 C.F.R. 41.41)**

**Attention: Board of Patent Appeals and Interferences**  
Commissioner for Patents  
Washington, DC 20231

Dear Sir:

This reply brief, filed pursuant to 37. C.F.R. § 41.41, is in response to the Examiner's Response, mailed in this case on October 6, 2005. Should the Primary Examiner not find the comments contained herein persuasive, acknowledgement of receipt and entry of this Reply Brief is requested.

The fees required under § 1.17(c) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL REPLY BRIEF.

This brief contains these items under the following headings:

- I. Reply to Examiner's Response
  - A. Reply to Examiner Comments on Brief Contents
    - 1. Summary of the Claimed Subject Matter
    - 2. Claim Grouping
  - B. Reply to Examiner's Response to the First Ground
  - C. Reply to Examiner's Response to the Second Ground
  - D. Reply to Examiner's Response to the Third Ground
- II. Conclusion

The final page of this brief bears the attorney's signature.

## **I. REPLY TO EXAMINER'S RESPONSE**

Based on a review of the Examiner's Answer, Appellant stands by and reasserts the arguments in support of the First, Second, and Third Issues advanced in the Appellant's Brief. However, comments are submitted herewith in reply to the Examiner's responsive arguments to the contents of the Appellant's Brief.

### ***A. Reply to Examiner's Comments on Brief Content***

Effective on September 13, 2004, the Patent and Trademark Office adopted new rules governing appeals to the Board of Patent Appeals and Interferences. Appellant filed the Appellant's Brief in full compliance with these rules.

#### ***1. Summary of Claimed Subject Matter***

On page 2 of the Examiner's Answer, the Examiner states that "The summary of the invention contained in the brief is deficient because the Applicant is [sic] only provided where in the specification each limitation of the claims is supported without providing a brief summary of the invention." Appellant responds that, after September 13, 2004, the previous "Summary of the Invention" section was replaced with a section entitled, "Summary of the Claimed Subject Matter." 37 CFR § 41.67(c)(v). According to § 41.67(c)(v), the Summary of the Claimed Subject Matter shall include, "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by column and line number, and to the drawing(s), if any, by reference characters. ..." Thus, while the Examiner contends that Appellant's Brief is deficient, the Examiner's own statement regarding the content of Appellant's Brief supports that Appellant's Brief fully-complies with the requirements of § 41.67(c)(v) by providing specification and figure citations showing support of each claim limitation of the independent claims.

#### ***2. Claim Grouping***

On page 2 of the Examiner's Answer, the Examiner also states that the Appellant's Brief does not comply with 37 CFR § 1.192(c)(7), by not including a statement that any grouping of claims does or does not stand or fall together. However, as of September 13,

2004, § 1.192 of the Code of Federal Regulations was removed and reserved in favor of the revised appeal rules in new Part 41 of Title 37. Thus, the rules to which the Examiner cites in claiming that the Appellant's Brief is deficient no longer exist. In fact, the new rules that were adopted did away with the requirement that an appellant in any matter make the statement that claim groupings stand or fall together. Instead, § 41.67(c)(vii) provides that an appellant need only argue the different claims separately for the Board to consider the separate patentability of any various claim groups. Therefore, Appellant's Brief was properly drafted according to the revised rules of Part 41 and could not be deficient of any information required under the now-removed 37 CFR § 1.192.

***B. Reply to Examiner's Response to the First Ground***

In his response, the Examiner contends that Appellant's assertion that *Coueignoux* is non-analogous art is, "unsupported by objective factual evidence and was not found to be substantial evidentiary value." Examiner's Answer, p. 13. The Examiner makes this statement even though Appellant included numerous cites to both *Coueignoux* and the claimed invention in a factual comparison of the features, limitations, and overall purpose of each invention. In response to Appellant's factual comparison, the Examiner merely summarizes the *Coueignoux* invention and, thereafter, concludes, "Similarly [sic] to the description provided by the Appellant's arguments page 5, lines 5-11 and specification of the instant application page 9, lines 15-27." Examiner's Answer, p. 13. The Examiner provides no more than this conclusive statement to either support his assertion that *Coueignoux* is analogous to the claimed invention or refute Appellant's detailed factual comparison supporting her assertion that *Coueignoux* is non-analogous.

In fact, the Examiner expends the remainder of his response to the First Ground attempting to show that *Coueignoux* is analogous to *Lang*. On page 14 of his Answer, the Examiner summarizes *Lang*, states that *Lang* does not explicitly disclose the use of transmitting a reputation information in response to an authorization received by the user, and then concludes that "One having ordinary skill in the art would have found it obvious to combine the teachings of *Lang* and *Coueignoux* ...." Examiner's Answer, pp. 14-15. However, the standard of analogy is not whether a secondary reference is analogous to the primary reference being used to support an obviousness rejection under 35 U.S.C. § 103(a), but rather, whether the reference is analogous to the claimed invention at issue. See *In re Oetiker*,

977 F.2d 1443, 1446 (Fed. Cir. 1992). The Examiner wholly fails to provide any support or reasoning as to how *Coueignoux* is analogous to the claimed invention.

As asserted in Appellant's Brief, and briefly summarized herein, *Coueignoux* describes a moderated communication between a sender of information requests and the user. The sender sends the request for information to an agent, while the agent deals directly with the user, extracting the information from the user. For private information, the user must give authorization to the agent to share the private information with the requester. Appellant's Brief, p. 8. In contrast, the claimed invention describes a central repository/database where the reputation information is stored. The party, about whom the reputation information applies, gives permission for the central repository/database to release this information to the various additional community organizations when such organizations properly access the central repository. Appellant's Brief, p. 8. Nothing argued by the Examiner provides adequate support that *Coueignoux* is analogous to the claimed invention.

Based on the foregoing arguments and the detailed, factual comparison between the *Coueignoux* reference and the claimed invention, Appellant contends that one of ordinary skill in the art would not have looked to the moderated communication technique of *Coueignoux* to add any features to a centralized clearinghouse for community identity information. Therefore, Appellant respectfully requests the Examiner's use of *Coueignoux* be overruled.

### **C. Reply to Examiner's Response to the Second Ground**

In response to the Second Ground, the Examiner asserts that Appellant "appears to misinterpret the guidance given under MPEP 2142." Examiner's Answer, p. 15. Appellant asserted in her Brief that, "Obviousness can only be established by combining or modifying the teachings, suggestions, or motivation to do so found *either* explicitly or implicitly in the references themselves *or in the knowledge generally available to one of ordinary skill in the art.*" Appellant's Brief, p. 9 (emphasis added.) Moreover, Appellant stated:

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicant contends that the Examiner has failed to meet his burden of proof and has, thus, failed to establish a *prima facie* case of obviousness by failing to meet at least one of the above three basic criteria. According to the Federal Circuit, the

suggestion or motivation to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Appellant's Brief, pp. 8-9.

Other than Appellant's assertion that the Examiner has failed to meet his burden, Appellant fails to see where her assertion of the law is different than that expressed by the Examiner.

The crux of Appellant's argument is that the Examiner improperly obtained the motivation to combine *Lang* with *Coueignoux* from the Appellant's disclosure. The Examiner states that the motivation to combine the user-consent from *Coueignoux* with *Lang* was to "ensure confidential information are only transmitted if consent for publication is affirmatively given." Examiner's Answer, p. 16. However, as Appellant has repeatedly argued, *Lang* already discloses security measures and safeguards for ensuring the validity and reliability of the reputation information. Appellant's Brief, p. 9 (*citing Lang*, paras. [0023] & [0042]). Therefore, the only possible motivation to combine the additional security measure of user-consent would come from Appellant's disclosure.

Based on the foregoing arguments, Appellant respectfully requests the Examiner's combination of *Lang* with *Coueignoux* to be overruled for lack of proper motivation.

***D. Reply to Examiner's Response to the Third Ground***

In his response to the Third Ground, the Examiner states that "Appellant should duly note that Schuba and Lambert were mentioned in the rejection of the last office action as pertinent prior art. They were not considered part of the rejection." Examiner's Answer, p. 18. However, the Examiner has repeatedly used teachings from *Schuba* and *Lambert* in the actual arguments and support of the Examiner's rejections. In the June 28, 2004, Office Action, the Examiner stated that *Schuba* and *Lambert* were not a part of the rejection, but still used teachings from parts of both *Schuba* and *Lambert* in supporting his rejections at pages 3, 6-7, and 9-10 of that Office Action. 6/28/2004 Office Action, pp. 3, 6-7, 9-10. Again, in the January 27, 2005, Final Office Action, the Examiner stated that *Schuba* and *Lambert* were not a part of the rejections, but continued, "On the other hand, Schuba and Lambert, when considered as a whole to one of ordinary skill in the art, make obvious the invention as claimed." 1/27/2005 Final Office Action, p. 12. The Examiner also used teachings from *Schuba* and *Lambert* in other parts of the Final Office action to support aspects of the rejections. 1/27/2005 Final Office Action, pp. 2, 3, and 5-6.



While Appellant concedes that the Examiner has stated that *Schuba* and *Lambert* are not a part of the rejections, Appellant asserts that the Examiner has, in fact, made *Schuba* and *Lambert* a part of the rejections by expressly citing to teachings in support of his rejections and by explicitly stating that the combination of *Schuba* and *Lambert* would render the claimed invention obvious. Therefore, Appellant continues to assert her remarks and arguments to the Third Ground.

## II. CONCLUSION

Based on the foregoing remarks and arguments, Appellant respectfully submits that claims 1-20 are patentable under 35 U.S.C. § 103(a). Reversal of the rejections is courteously requested.

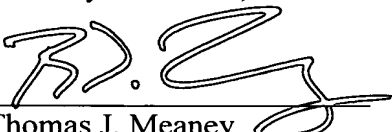
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV629198717, in an envelope addressed to: Board of Patent Appeals and Interferences, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: November 30, 2005

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Respectfully submitted,

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Thomas J. Meaney  
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Date: November 30, 2005

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